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**OFFICE OF PETITIONS**

In re Patent No. 5,420,107 :  
Issue Date: May 30, 1995 :  
Application No. 08/279,829 : DECISION ON PETITION  
Filed: July 25, 1994 :  
Attorney Docket No. 01098-32767 :  
:

This is a decision on the petition under 37 C.F.R. §1.378(b),  
filed July 26, 2010.

The petition under 37 C.F.R. § 1.378(b) is DISMISSED.

**Background:**

The above-identified patent issued on May 30, 1995. Accordingly,  
the third maintenance fee could have been timely paid during the  
period from May 30, 2006 through November 30, 2006, or with a  
late payment surcharge during the period from December 1, 2006  
through May 30, 2007. No maintenance fee having been received,  
the patent expired on May 31, 2007. Patentee filed the instant  
petition to accept the unavoidably delayed payment of the  
maintenance fee pursuant to 37 C.F.R. 1.378(b) on July 26, 2010.

With the instant petition, petitioner states that he was not reminded by his counsel of the twelve year maintenance fee. According to petitioner, his counsel not only prosecuted the application, but tracked and payed the four year and eight year maintenance fees for petitioner.

**Relevant Statutes and Regulations:**

35 U.S.C. § 41(c)(1) states that:

The Commissioner may accept the delayed payment of any maintenance fee required ... after the six month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable.

37 C.F.R. § 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

(1) The required maintenance fee set forth in §1.20(e) through (g);

(2) The surcharge set forth in §1.20(i)(1); and

(3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

§ 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. In

addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account."

Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32 (N.D. Ind. 1987).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960) (35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991), cert. denied, 502 U.S. 1075 (1992); Ray v. Lehman, 55 F. 3d 606, 608 - 609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

#### Analysis:

Petitioner has not demonstrated unavoidable delay within the meaning of 35 U.S.C. §41(c)(1) and 37 C.F.R. § 1.378(b).

While it is unfortunate that petitioner's counsel did not remind him of the twelve year maintenance fee when it became due, petitioner is bound by any errors or negligence that may have been committed by his voluntarily chosen counsel. See Link v. Wabash, 370 U.S. 626, 633-34 (1962). Petitioner's recourse lies against his counsel.

#### Conclusion:

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in § 1.17(f). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that petitioner supply any and all relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with

direct knowledge of the cause of the delay, setting forth the facts as they know them.

If on request for reconsideration, the delayed payment of the maintenance fee is not accepted, then the maintenance fee and the surcharge set forth in §1.20(i) are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. (Petitioner may request a refund of the maintenance fee and surcharge by writing to the Mail Stop 16, Director of the USPTO, P.O. Box 1450, Alexandria VA 22313-1450). A copy of the last decision rendered should accompany the request for refund).

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petitions  
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Telephone inquiries concerning this communication should be directed to the undersigned at 571-272-3207.



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